REMARKS

The July 17, 2007 Office Action regarding the above-identified application has been carefully considered; and the claim amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. The independent claims have been amended to more clearly distinguish over applied art. Dependent claims have been amended to address concerns regarding indefiniteness, although such amendments should not affect the scope of claim coverage. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

Summary of the Latest Action

Claims 11, 13, 15, 17, 20, 21 and 23-39 were active in this application at the time of the July 17, 2007 Office Action.

The Action initially indicated that several dependent claims (20, 23, 25, 36 and 39) were withdrawn on the ground that they now recite independent and distinct subject matter not previously considered in the examined claims.

Claims 20, 21, 23-27, 29 and 31-39 were rejected under as 35 U.S.C. § 112 as indefinite.

The Office Action rejected claims 11, 13, 15, 17 and 28-33 under 35 U.S.C. § 102(e) as anticipated by U.S. Publication 2006/0100929 to Spector.

Claims 31, 35 and 38 were rejected under 35 U.S.C. §103 as unpatentable over the Spector publication.

The Office Action rejected claims 21, 24, 26 and 27 as unpatentable over Spector in view of U.S. Publication 2002/0035568 to Benthin et al. (hereinafter Benthin).

Claims 34 and 37 were rejected as unpatentable over Spector in view of U.S. Patent No. 4,674,041 to Lemon et al. (hereinafter Lemon).

The Office Action also rejected claims 11, 13, 15, 17, 20, 21 and 23-33 as unpatentable over Spector in view of U.S. Patent No. 6,282,713 to Kitsukawa et al. (hereinafter Kitsukawa).

Claims 34 and 37 were further rejected as unpatentable over a combination of Spector, Kitsukawa and Lemon.

The Response

Claims 11, 13, 15, 17, 29, 31-35, 37 and 38 remain active in this application, of which claims 11, 13, 15 and 17 are independent claims.

Withdrawn non-elected claims 20, 23, 25, 36 and 39 have been cancelled, without prejudice or disclaimer. Applicants reserve the right to file one or more divisional applications directed to the subject matter of those claims.

The independent claims have been amended to recite a determination of a fee that is necessary for the broadcasting or transmitting of the program or commercial message, on the basis of the number of issuances of the shopping coupon, which a provider of the program or commercial message to is required to pay. The independent claims also have been amended to recite that the fee is made higher as the number of issuances of the shopping coupon increases. It is submitted that the new claim language finds support in the original disclosure, for example, in the detailed description running from line 15 of page 18 to line 4 of page 19 of the specification. Also, in view of such amendments, dependent claims that recited higher fees (such as 21, 24, 26 and 27) have been deleted. Care has been taken in drafting the amendments to the independent claims to avoid concerns regarding definiteness raised in the 112 rejection of the dependent

claims. As discussed more below, the fee related recitations help to distinguish the claimed subject matter over prior art.

The independent claims also have been amended to recite that the issuance request includes information on the program or commercial message including a name of the program or commercial message and date, time and a channel via which the program or commercial message is broadcasted/transmitted. It is submitted that the new claim language finds support in the original disclosure, for example, in FIG. 2A and the discussion thereof in the detailed description. Claims 28 and 30 previously recited of the program or message title, date, time and channel; and those claims have been cancelled in view of the amendments to the independent claims. Care has been taken in drafting the amendments to the independent claims to avoid concerns regarding definiteness raised in the 112 rejection of the dependent claims. As discussed more below, the recitations regarding program name, date, time and channel help to distinguish the claimed subject matter over prior art.

Claims 29, 31-35, 37 and 38 have been amended to address the issues raised in the 112 rejection.

In view of the claim amendments above, it is believed that the indefiniteness issues raised in the 112 rejection have been overcome, in a manner essentially as suggested by the comments in that rejection. Withdrawal of the indefiniteness rejection is respectfully requested.

As summarized earlier, the other issues raised in the Office Action relate to novelty and patentability over art. For reasons discussed more fully below, it is respectfully submitted that the amended claims distinguish over the art applied in the latest Office Action and therefore are novel and patentable over art.

Novelty over Spector

Independent claims 11, 13, 15, 17 and dependent claims 29 and 31-33 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Publication 2006/0100929 to Spector. It is respectfully submitted that the amended independent claims distinguish over Spector and that the anticipation rejection should be withdraw.

Each of the amended independent claims recites a means element, the function of which is to determine a fee necessary for the broadcasting or transmitting of the program or commercial message. As clearly recited in the independent claims, this is a fee that the provider is required to pay, and that fee is determined on the basis of the number of issuances (claims 11 and 15) or the number of uses (claims 13 and 17) of the shopping coupon. Also, the fee gets higher as the number of issuances or uses of the shopping coupon increases.

Spector adjusts the discount rate of the coupon depending on the redemption rate of the coupon ([0039]). However, Spector does not mention any relationship between the coupon redemption rate and the broadcast of the commercial message. Spector is also silent on charging the provider of the program or commercial message. Accordingly, Spector does not disclose determining a fee necessary for the broadcasting or transmitting of the program or commercial message, on the basis of the number of issuances or uses of the shopping coupon, nor that such a fee increases with increasing number of issuances or increasing number of uses of the coupon.

Each of the independent claims also recites that the received shopping coupon issuance request includes the identifier of the shopping coupon as well as information on the program or commercial message. The information on the program or message includes a name of the program or commercial message as well as date, time and a channel via which the program or commercial message is broadcasted/transmitted. The additional information makes it possible to

know the correspondence between the coupon and the program or channel and facilitates compiling a history for each program or commercial message.

In addressing former claims 28 and 30, the rejection asserted that Spector includes the time of the commercial as part of the request. Actually, the user's PVR 14 and computer provide the user response/request to a data relay station ([0033]). The data relay station 24 of Spector provides the user response (from the user's PVR and computer) and provides profile information and time information, i.e., what product is being shown when a user is viewing a commercial ([0030] and [0033]) to the coupon generator 10. This is not enough to meet the amended independent claim requirements. For example, Spector would not meet the requirement that the information attached to the coupon issuance request from the receiving station includes (1) the name of the program or commercial message and (2) the channel via which the program or commercial message is broadcasted/transmitted.

Also, the operations of the claimed subject matter in relation to coupon issuance are different from Spector. In Spector, the user pushes a button ([0032]) to send a coupon request and receives the coupon via the phone line ([0033] and [0037]). The data relay station provides profile and time information ([0033]). In the systems recited in the present claims, the receiver receives the coupon information and generates the coupon issuance request using the received coupon information. Spector does not disclose sending the coupon information with the program or message, only transmission of the request during commercial display. As a result, Spector does not show the "coupon information sending means" in the service center or the broadcasting unit and the "information attaching means" in the receiver, as recited in the independent claims listed above.

In view of these distinctions of the present independent claims over Spector, it is believed that Spector does not anticipate any of claims 11, 13, 15, 17 or dependent claims 29 and 31-33. Applicants therefore request that the Examiner withdraw the anticipation rejection over Spector.

Patentability over Spector

Remaining dependent claims 31, 35 and 38 were rejected under 35 U.S.C. §103 as unpatentable over the Spector publication. This rejection alleges that it would have been obvious to modify the system of Spector to collect demographic data, e.g. age and gender, of coupon users. However, such a modification would not result in a system which determines the program or message fee based on number of coupons (issuances or uses), collects information as to the program name and channel from the received coupon issuance request, or issues the coupon in response to a request containing the coupon identifier as well as the program or message information, in the manner recited in Applicants independent claims. Since dependent claims 31, 35 and 38 include the limitations of the respective independent claims, claims 31, 35 and 38 similarly distinguish over the allegedly obvious modification of Spector. Hence, claims 31, 35 and 38 should be patentable over Spector, and Applicants request withdrawal of the patentability rejection of those claims over Spector.

Patentability over Spector in view of Benthin

The Office Action rejected claims 21, 24, 26 and 27 as unpatentable over Spector in view Benthin. These claims recited setting either time period or a fee in relation to coupon issuances or uses, and the rejection cites Benthin for a teaching to set the time period for a coupon campaign based on results (e.g. by continuing or extending a successful campaign). The former dependent claims have been cancelled, however, the independent claims have been amended to include fee related limitations. The independent claims do not recite the time setting, as an

alternative, as did the earlier dependent claims. As a result, the independent claims clearly distinguish over the combination of Spector and Benthin on the point by positively requiring the fee determination.

As discussed above, Spector mentions a relation between the coupon available time and the discount rate ([0036]), however, Spector is silent on determining the broadcasting fee and charging the provider. Benthin discloses an apparatus for controlling an automatic presentation of information to a customer, and that publication mentions a relationship between the promotion campaign length and the response to a campaign. Paragraph 0041, for example, indicates that the campaign editor 20 can display statistics for viewing and/or printing by the user, allowing the user to detect trends as well as simple success and failure of a campaign in order to provide an opportunity to optimize a campaign, cancel a campaign or continue with a campaign. However, Benthin is silent on determining the fee or charging the provider. Hence, the combination of Spector and Benthin would still not result in a system that determines a fee necessary for the broadcasting or transmitting of the program or commercial message, on the basis of the number of issuances or uses of the shopping coupon, or that increases such a fee with increasing number of issuances or increasing number of uses of the coupon.

Also, the data relay station of Spector forwards the user response and provides profile information and time information, i.e., what product is being shown when a computer is viewing a commercial ([0030]). This is not enough to meet the amended independent claim requirements regarding information contained in the coupon issuance request generated at the receiver. As claimed, the receiver generates the request and attaches the information about the program or message; and that attached information includes name of the program or commercial message and the channel via which the program or commercial message is broadcasted/transmitted. Setting the time period for the coupon campaign (Benthin) would still not meet this additional

requirement. Hence, the combination of Spector and Benthin would still not result in a system that meets claim requirements regarding attaching information such as name and channel about the program or channel in the coupon request.

Furthermore, since Spector does not disclose sending the coupon information together with the program or commercial message, it is believed that the combination of Spector and Benthin does not provide the "coupon information sending means" in the service center or the broadcasting unit or the "information attaching means" in the receiver, as recited in the independent claims listed above.

As explained above, there are several aspects of Applicants' independent claims that would not be met by the combination of Spector and Benthin. Accordingly, claims 11, 13, 15 and 17 and the claims that depend therefrom should be patentable over that combination, and the patentability rejection over Spector and Benthin should be withdrawn.

Patentability over Spector in view of Lemon

Applicants respectfully traverse the rejection of claims 34 and 37 as unpatentable over Spector in combination with Lemon, in view of the amendments to the independent claims. The rejection cites Lemon for teaching a limit or threshold on number of coupons. However, claims 34 and 37 depend from claims 11 and 13, respectively, and therefore include patentable distinctions over Spector as discussed above relative to claims 11 and 13. Addition of a limit or threshold would not overcome the deficiencies of Spector, therefore claims 34 and 37 should be patentable of Spector and Lemon for the same reasons that claims 11 and 13 are patentable over Spector.

Patentability over Spector in view of Kitsukawa

Pending claims 11, 13, 15, 17, 29 and 31-33 also stand rejected under an alternative theory, specifically, for alleged obviousness over Spector in view of Kitsukawa. This rejection is traversed on the ground that the combination of Spector and Kitsukawa would not satisfy all requirements of any of Applicants' amended independent claims.

As discussed earlier, Spector does not disclose a system which determines the program or message fee based on number of coupons (issuances or uses), collects information as to the program name and channel from the received coupon issuance request, or issues the coupon in response to a request containing the coupon identifier as well as the program or message information, in the manner recited in Applicants independent claims. The addition of Kitsukawa does not make up for all of these deficiencies of Spector.

For example, it is submitted that the Spector and Kitsukawa documents would not lead one of ordinary skill in the art to determine the fee for a program or commercial message, in the manner recited in Applicants' claims.

Kitsukawa discloses a home terminal system for receiving communications, including coupon information, and capturing information for selected coupons on-demand, in response to user selections. In Kitsukawa, the user system stores the data set including the coupon information and the television program data on a removable recording medium (column 11, lines 37 to 54). The information collection center collects the information on the TV programs from the user systems and uses the collected data for statistical analysis purposes (column 12, lines 1-20). However, Kitsukawa does not describe counting accesses from the audiences to the displayed advertised information and thus does not mention determining a fee for the program or commercial message according to the access count, particularly for the use in managing broadcast or transmission. The collection center of Kitsukawa only collects the television

program data but not any information regarding the coupon (see column 12, lines 7-20). This is different from the claimed arrangements in which both of the coupon identifier and the program/commercial message information are sent and managed together by the "request receiving means" and the "history storing means."

Further, in Kitsukawa, the information collection center collects the information on the TV programs from the user systems and uses the collected data for statistical purposes. However, Kitsukawa is not specific as to how to use the statistical data and does not mention determining a fee necessary for broadcasting the program or commercial message to charge the provider. That is, Kitsukawa does not show the "broadcasting/transmitting managing means," either.

The Examiner apparently recognizes that Kitsukawa, like Spector, does not teach charging a fee based on number of coupons (issuances or uses). Instead, as the rejection takes official notice of charges for commercial broadcasts and asserts that charging a fee would have been obvious. However, neither Spector nor Kitsukawa teaches the specific fee requirements of the claims, and the official notice does not identify any particular source for a teaching specifically of **charging a provider** of the program or commercial message **based on number of issuances or uses of a coupon** for which information was communicated with the program or commercial message. It is respectfully submitted that general knowledge of charging for program or message transmissions is not enough to teach one of skill in the art to determine a fee for a provider to pay in relation to a program or commercial message based on number of issuances or uses of a coupon for which information was communicated with the program or commercial message, as recited in the amended claims above. Absent a prior art reference showing the specific fee determination recited in the claims or some other evidence of relevant knowledge on the point prior to the effective date of this application, the Examiner has failed to

make a prima facie case that the claims as a whole would have been obvious. The burden rests on the Office, and thus the Examiner, to show that the elements/functions recited in the claims were known in the art; and that burden has not been met here.

For the reasons outlined above, it is submitted that Spector and Kitsukawa together would not fairly suggest all aspects of any of the pending independent claims to a person of skill in the art. Accordingly, the independent claims as well as the claims that depend therefrom should be patentable over Spector and Kitsukawa. Applicants therefore respectfully request that the Examiner withdraw the rejection of claims 11, 13, 15, 17, 29 and 31-33 over Spector in view of Kitsukawa.

Patentability over Spector in view of Kitsukawa Further in view of Lemon

Applicants respectfully traverse the alternative rejection of claims 34 and 37 as unpatentable over Spector in combination with Kitsukawa further in combination with Lemon, in view of the amendments to the independent claims. The rejection cites Lemon for teaching a limit or threshold on number of coupons. However, claims 34 and 37 depend from claims 11 and 13, respectively, and therefore include patentable distinctions over Spector and Kitsukawa as discussed above relative to claims 11 and 13. Addition of a limit or threshold would not overcome the deficiencies of the Spector-Kitsukawa combination, therefore claims 34 and 37 should be patentable of Spector, Kitsukawa and Lemon for the same reasons that claims 11 and 13 are patentable over Spector.

Conclusions

Upon entry of the above claim amendments, claims 11, 13, 15, 17, 29, 31-35, 37 and 38 remain active in this application, all of which should be definite as well as novel and patentable over the art applied in the latest Office Action. Accordingly, this case should now be ready to

pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the July 17, 2007 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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